



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/657,310  | 09/08/2003  | Robert G. Skinner    | C-507/TEC1215-01    | 9729             |
| 832   | 7590        | 06/22/2005           | EXAMINER            |                  |
| BAKER & DANIELS LLP<br>111 E. WAYNE STREET<br>SUITE 800<br>FORT WAYNE, IN 46802 |             |                      | TRIEU, THERESA      |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3748                |                  |

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/657,310

Applicant(s)

SKINNER, ROBERT G.

Examiner

Theresa Trieu

Art Unit

3748

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 6 and 10 is/are rejected.
- 7) ☒ Claim(s) 2-4 and 7-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on June 11, 2004 and June 21, 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/8/03, 8/30/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Priority*

Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

*1. Claims 1, 5, 6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elson (Patent Number 4,895,496) in view of Sakurai et al. (Sakurai) (Patent Number 5,110,268).*

Regarding claims 1, 5, 6 and 10, as shown in Figs. 1-3, Elson discloses a compressor assembly comprising: a housing (12); a stationary scroll member (28) fixed within the housing; an orbiting scroll member (30) disposed within the housing and engaged with the stationary scroll member; a motor; a crankcase (32) disposed between the motor (16) and the orbiting scroll; a bearing support member (34) fixed within the housing and having a bearing mounted thereto; an elongate shaft (26) rotatable about a shaft axis and having a first end and an opposite second end, the shaft extending through the crankcase and the motor, the first end operably coupled with the orbiting scroll, the bearing rotatably supporting the shaft proximate the second

Art Unit: 3748

end, a counterweight (42) rotationally coupled with the shaft (26) proximate the bearing support member (34); an oil sump (not numbered; however, clearly seen in Fig. 1) disposed within an interior plenum defined by the housing (14); and an oil shield (12) having a plurality of flexible members mounting the oil shield to the bearing support (34), the oil shield (12) having a substantially cylindrical portion extending outwardly from the bearing support (34) and encircling at least a portion of the counterweight (42); the motor (16) includes a rotor (22) rotationally coupled to the shaft (26) and the counterweight (42) being disposed on the rotor. However, Elson fails to disclose the compressor being a horizontal compressor.

Sakurai teaches that it is conventional in the art to utilize a horizontal compressor. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized the horizontal compressor as taught by Sakurai in the Elson device since both types of compressor are shown to be conventionally utilized to compress a liquid.

#### *Allowable Subject Matter*

2. Claims 2-4 and 7-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Prior Art*

The IDS (PTO-1449) filed on September 8, 2003 and August 30, 2004 has been considered. An initialized copy is attached hereto.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and consists of six patents: Horn (U.S. Patent Number 5,064,356), Siebel (U.S. Patent Number 5,176,506), Fain (U.S. Patent Number 5,372,490), Mitsunaga et al. (U.S. Patent Number

Art Unit: 3748

6,322,339), Osada et al. (Publication Number JP 05-180178), and Kobayashi et al. (Publication Number JP 06-235387), each further discloses a state of the art.

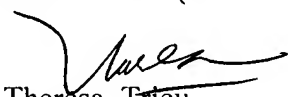
*Communication*

.Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa Trieu whose telephone number is 571-272-4868. The examiner can normally be reached on Monday-Friday 8:30am- 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on 571-272-4859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TT  
June 16, 2005

  
Theresa Trieu  
Primary Examiner  
Art Unit 3748